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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PONNALURI, PADMASHRI

ART UNIT PAPER NUMBER

1639

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary*Restriction Purpose Only*

Application No.

10/082,671

Applicant(s)

DAHIYAT ET AL.

Examiner

Padmashri Ponnaluri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, drawn to a method of creating a protein-binding profile of a test compound, classified in class 435, subclass 69.7.
 - II. Claim 6, drawn to a method of determining the toxicity of a compound, comprising, a) providing a protein binding profile of the first compound, and protein binding profile of a second compound, classified in class 435, subclass 6.
 - III. Claim 7, drawn to a method of determining the toxicity of a compound comprising, a) a first protein binding profile, and a second protein binding profile of the compound classified in class 435, subclass 6.
 - IV. Claim 8, drawn to a method of determining the toxicity of a compound comprising, a) a first protein binding profile of the compound, and the compound is known to have a toxic effect at a first organ of an animal species; b) a second protein binding profile, and the coding sequence of the candidate protein is derived from a second animal, classified in class 435, subclass 6.
 - V. Claim 9, drawn to a method of determining the toxicity of a compound comprising, a) a first protein binding profile of the compound, and the compound is known to have a toxic effect in an animal species at first developmental stage; b) a second protein binding profile, and the coding sequence of the candidate protein is derived from the first animal at second developmental stage, classified in class 435, subclass 6.

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- VI. Claim 10, drawn to a method of determining the toxicity of a compound comprising, providing a protein binding profile of different compounds, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of groups I-VI are all drawn to patentably distinct methods. The different methods of groups I-VI are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

In the instant case the different inventions of groups I-VI all have different method steps, and the reagents used are different (i.e., different number of test compounds, and different candidate proteins used in the methods). Thus, restriction between the groups is proper.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Even though some of the groups are classified in the same class/subclass, this has no effect on the non-patent literature search. Different inventions or groups would require completely different searches in non-patent databases, and there is no exception that the searches would be co-extensive. Therefore, these do not create an undue search burden, and restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

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A) If group I is elected, applicants are requested to elect a single species for each of the following:

- a) a single species of NAM enzyme;
- b) a single species of candidate protein;
- c) one single sequence of Enzyme Attachment Sequence.

B) If group II is elected, applicants are requested to elect a single species for each of the following:

- a) a single species of NAM enzyme;
- b) a single species of candidate protein;
- c) one single sequence of Enzyme Attachment Sequence;
- d) a single species of first compound.

C) If group III is elected, applicants are requested to elect a single species for each of the following:

- a) a single species of NAM enzyme;
- b) a single species of candidate protein;
- c) one single sequence of Enzyme Attachment Sequence;
- d) a single species of first compound.

D) If group IV is elected, applicants are requested to elect a single species for each of the following:

- a) a single species of NAM enzyme;
- b) a single species of candidate protein;
- c) one single sequence of Enzyme Attachment Sequence;

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d) a single species of first compound;

e) first organ of the animal species;

f) second organ of the animal species.

E) If group V is elected, applicants are requested to elect a single species for each of the following:

a) a single species of NAM enzyme;

b) a single species of candidate protein;

c) one single sequence of Enzyme Attachment Sequence;

d) a single species of first compound;

e) first developmental stage;

f) second developmental stage.

G)) If group VI is elected, applicants are requested to elect a single species for each of the following:

a) a single species of NAM enzyme;

b) a single species of candidate protein;

c) one single sequence of Enzyme Attachment Sequence;

d) a single species of first compound.

e) a single species of the compound or protein or gene listed in claim 10.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

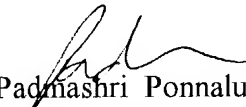
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 571-272-0809. The examiner is on Increased Flex Schedule and can normally be reached on Monday through Friday between 7 AM and 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Padmashri Ponnaluri
Primary Examiner
Art Unit 1639

Pp
02 June 2004